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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,345	11/30/2004	Riccardo Abate	71632	9500

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EXAMINER	
HUSON, MONICA ANNE	
ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/516,345	ABATE ET AL.	
	Examiner	Art Unit	
	Monica A. Huson	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) *7-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 11-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 November 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *113004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

It is noted that this Office Action does not include all rejections proposed by the International Search Report. The examiner believes that stating each rejection proposed by the International Search Report would be repetitive and merely cumulative in nature.

Election/Restrictions

Applicant's election with traverse of Claims 1-6 and 11-14 in the reply filed on 5 July 2006 is acknowledged. The traversal is on the ground(s) that, "[t]his is essentially a product by process claim. Although the process steps themselves are not claimed, the structure which results from this is particular to the method and the structure had aspects which are directly related to the method". This is not found persuasive because even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). (See MPEP 2113) Per the restriction requirement mailed 6 June 2006 by Examiner O'Hern, it is maintained that WO 02/074522 shows the film bag, and that the special technical feature, a method of forming a film, does not provide a contribution over the prior art, and no single general inventive concept exists.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujii et al. (EP 0 836 927). Regarding Claim 1, Fujii et al., hereafter "Fujii," show that it is known to carry out a method of forming a film made up of at least one external layer made of a gas-proof plastic material and by an internal layer made of a thermoplastic material (Abstract; Page 2, lines 14-18), characterized by the steps of depositing, using an extruder, an additional resin film on the internal layer of the initial film, the additional resin being the same as or compatible with the thermoplastic material of said internal layer (Figure 2, elements 12, 13; Page 2, lines 45-50); having the initial film complete with additional film to pass between a smooth feed roller and a shaping roller having a number of peripheral impressions (Figure 2, elements 21, 16); and placing said additional film in close contact with said shaping roller so as to have portions of additional hot resin upset into the peripheral impressions of the shaping roller, forming corresponding ridges protruding from the internal surface of the composite film and defining a network of ducts (Figure 2, elements 13, 16, 15).

Regarding Claim 2, Fujii shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the additional resin

is deposited on the surface of the internal layer of the initial film which has been previously prepared (Figure 2, elements 13, 12, 17).

Regarding Claim 3, Fujii shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the shaping roller has isolated peripheral recesses to define the protrusions in the form of blisters with the added resin film (Figure 2, elements 13, 16, 15).

Regarding Claim 5, Fujii shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the shaping roller has a multiplicity of peripheral grooves that extend in compliance with the axis of the roller itself to define together with the additional resin film an equivalent number of ridges with ducts oriented crosswise to the length of the film (Figure 2, elements 16, 15).

Regarding Claim 11, Fujii shows the process as claimed as discussed in the rejection of Claim 2 above, including a method wherein the shaping roller has isolated peripheral recesses to define the protrusions in the form of blisters with the added resin film (Figure 2, elements 13, 16, 15).

Regarding Claim 13, Fujii shows the process as claimed as discussed in the rejection of Claim 2 above, including a method wherein the shaping roller has a multiplicity of peripheral grooves that extend in compliance with the axis of the roller itself to define together with the additional resin film an equivalent number of ridges with ducts oriented crosswise to the length of the film (Figure 2, elements 16, 15).

Claims 1-3, 6, 11, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (WO 02/066227).

Regarding Claim 1, Lee shows that it is known to carry out a method of forming a film for the construction of bags for vacuum packing of products starting from a film made up of at least one external layer made of a gas-proof plastic material and by an internal layer made of a thermoplastic material

(Abstract; Page 4, lines 17-29; Page 6, lines 1-9), characterized by the steps of depositing, using an extruder, an additional resin film on the internal layer of the initial film, the additional resin being the same as or compatible with the thermoplastic material of said internal layer (Abstract; Figure 3, elements 30, 10; Page 4, lines 17-29; Page 6, lines 1-9); having the initial film complete with additional film to pass between a smooth feed roller and a shaping roller having a number of peripheral impressions (Figure 3, elements 20', 20, 21); and placing said additional film in close contact with said shaping roller so as to have portions of additional hot resin upset into the peripheral impressions of the shaping roller, forming corresponding ridges protruding from the internal surface of the composite film and defining a network of ducts (Figure 3, elements 20', 20, 21; Figure 5).

Regarding Claim 2, Lee shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the additional resin is deposited on the surface of the internal layer of the initial film which has been previously prepared (Figure 3, elements 10, 30).

Regarding Claim 3, Lee shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the shaping roller has isolated peripheral recesses to define the protrusions in the form of blisters with the added resin film (Figure 5, elements 41, 42).

Regarding Claim 6, Lee shows the process as claimed as discussed in the rejection of Claim 1 above, including a method in the prior art wherein the shaping roller has a multiplicity of peripheral crossing grooves to define with the additional resin film an equivalent number of ducts which cross each other (Figure 2, elements 115, 116; Figure 3, element 21; Page 3, lines 1-23; Page 7, lines 3-14).

Regarding Claim 11, Lee shows the process as claimed as discussed in the rejection of Claim 2 above, including a method wherein the shaping roller

has isolated peripheral recesses to define the protrusions in the form of blisters with the added resin film (Figure 5, elements 41, 42).

Regarding Claim 14, Lee shows the process as claimed as discussed in the rejection of Claim 2 above, including a method in the prior art wherein the shaping roller has a multiplicity of peripheral crossing grooves to define with the additional resin film an equivalent number of ducts which cross each other (Figure 2, elements 115, 116; Figure 3, element 21; Page 3, lines 1-23; Page 7, lines 3-14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii.

Regarding Claim 4, Fujii shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not show the claimed specific configuration of features on the shaping roller. However, to be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. (See *Ex parte Pfeiffer* 135 USPQ 31) There is no indication that the surface features of the shaping roller have a manipulative effect on the method steps (e.g. placing said additional film in close contact with said shaping roller so as to have portions of additional hot resin upset into the peripheral impressions of the shaping roller, forming corresponding ridges protruding from the internal surface of the composite film and defining a

network of ducts). Therefore, it is being interpreted that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use a shaping roller with any configuration of surface features, including a configuration as claimed, during Fujii's molding method in order to obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Regarding Claim 12, Fujii shows the process as claimed as discussed in the rejection of Claim 2 above, but he does not show the claimed specific configuration of features on the shaping roller. However, to be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. (See *Ex parte Pfeiffer* 135 USPQ 31) There is no indication that the surface features of the shaping roller have a manipulative effect on the method steps (e.g. placing said additional film in close contact with said shaping roller so as to have portions of additional hot resin upset into the peripheral impressions of the shaping roller, forming corresponding ridges protruding from the internal surface of the composite film and defining a network of ducts). Therefore, it is being interpreted that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use a shaping roller with any configuration of surface features, including a configuration as claimed, during Fujii's molding method in order to obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee.

Regarding Claim 4, Lee shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not show the claimed specific configuration of features on the shaping roller. However, to be entitled to

weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. (See *Ex parte Pfeiffer* 135 USPQ 31) There is no indication that the surface features of the shaping roller have a manipulative effect on the method steps (e.g. placing said additional film in close contact with said shaping roller so as to have portions of additional hot resin upset into the peripheral impressions of the shaping roller, forming corresponding ridges protruding from the internal surface of the composite film and defining a network of ducts). Therefore, it is being interpreted that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use a shaping roller with any configuration of surface features, including a configuration as claimed, during Lee's molding method in order to obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Regarding Claim 12, Lee shows the process as claimed as discussed in the rejection of Claim 2 above, but he does not show the claimed specific configuration of features on the shaping roller. However, to be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. (See *Ex parte Pfeiffer* 135 USPQ 31) There is no indication that the surface features of the shaping roller have a manipulative effect on the method steps (e.g. placing said additional film in close contact with said shaping roller so as to have portions of additional hot resin upset into the peripheral impressions of the shaping roller, forming corresponding ridges protruding from the internal surface of the composite film and defining a network of ducts). Therefore, it is being interpreted that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use a shaping roller with any configuration of surface features, including a configuration as claimed, during Lee's molding method in order to

obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii, in view of Lee.

Regarding Claim 6, Fujii shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not show the claimed specific configuration of features on the shaping roller. Lee shows that it is known to carry out a method in the prior art wherein the shaping roller has a multiplicity of peripheral crossing grooves to define with the additional resin film an equivalent number of ducts which cross each other (Figure 2, elements 115, 116; Figure 3, element 21; Page 3, lines 1-23; Page 7, lines 3-14). Lee and Fujii are combinable because they are concerned with a similar technical field, namely, methods of molding composite films with designs on one of the layers of the composite film. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Lee's specific shaping roller configuration during Fujii's molding process in order to obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Regarding Claim 14, Fujii shows the process as claimed as discussed in the rejection of Claim 2 above, but he does not show the claimed specific configuration of features on the shaping roller. Lee shows that it is known to carry out a method in the prior art wherein the shaping roller has a multiplicity of peripheral crossing grooves to define with the additional resin film an equivalent number of ducts which cross each other (Figure 2, elements 115, 116; Figure 3, element 21; Page 3, lines 1-23; Page 7, lines 3-14). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Lee's specific shaping roller configuration during

Fujii's molding process in order to obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, in view of Fujii.

Regarding Claim 5, Lee shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not show the claimed specific configuration of features on the shaping roller. Fujii shows that it is known to carry out a method wherein the shaping roller has a multiplicity of peripheral grooves that extend in compliance with the axis of the roller itself to define together with the additional resin film an equivalent number of ridges with ducts oriented crosswise to the length of the film (Figure 2, elements 16, 15). Fujii and Lee are combinable because they are concerned with a similar technical field, namely, methods of molding composite films with designs on one of the layers of the composite film. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Fujii's specific shaping roller configuration during Lee's molding process in order to obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Regarding Claim 13, Lee shows the process as claimed as discussed in the rejection of Claim 2 above, but he does not show the claimed specific configuration of features on the shaping roller. Fujii shows that it is known to carry out a method wherein the shaping roller has a multiplicity of peripheral grooves that extend in compliance with the axis of the roller itself to define together with the additional resin film an equivalent number of ridges with ducts oriented crosswise to the length of the film (Figure 2, elements 16, 15). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Fujii's specific shaping roller configuration

during Lee's molding process in order to obtain a composite film which meets exclusive end-use specifications regarding its surface geometric features.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 6:45am-3:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica A Huson

Monica A Huson

July 17, 2006